



DocCode: AP.PRE.REQ

PTO/SB/SS (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
1530

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on September 14, 2006

Signature

Typed or printed

name Lawrence H. AaronsonApplication Number
10/609,173Filed
June 27, 2003First Named Inventor
John PopeArt Unit
2618Examiner
Dominic E. Rego

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 35,818

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Lawrence H. Aaronson

Typed or printed name

312 913-2141

Telephone number

September 14, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

American LegalNet, Inc.
www.USCourtForms.com

channels that defines the bearer data is then generated, and the analog signal is transmitted to at least one wireless terminal.

Claim 1 defines the invention as involving the steps of receiving the digital signal, parsing the power level and modulation frequency from the control information defined by the signal, generating the analog signal based on the power level and modulation frequency, and transmitting the analog signal. Similarly, claim 9 defines the invention as a system that includes a receiver for receiving the digital signal, a parser for parsing the power level and modulation from the control information, means for generating the analog signal based on the power level and modulation frequency, and an RF power amplifier for transmitting the analog signal. Claim 11, like claim 9, recites the receiver and parser and further recites a spreading unit, a power control unit, an adder, a digital-to-analog converter, and a modulator. And claim 18 recites a system including a radio link converter arranged to carry out the receiving, parsing, generating, and transmitting functions as in claim 1.

The Examiner rejected each of these independent claims as being anticipated by U.S. Patent No. 6,781,980 (Dajer). However, Dajer fails to disclose all of the limitations of any of the independent claims. Therefore, Dajer does not anticipate any of the claims.

At a minimum, Dajer does not disclose the functions of (a) receiving a digital signal that defines both bearer data for each of a plurality of channels and control information for each of the plurality of channels and (b) parsing the power level and the modulation frequency from the control information, where the power level and modulation frequency are then used as a basis to generate an analog signal (defining the bearer data) for transmission to at least one mobile station.

In rejecting the claims, the Examiner asserted that Dajer teaches (a) receiving a digital signal that defines bearer data and control information and (b) parsing from the control

information a power level and modulation frequency. However, a review of Dajer reveals no such disclosure and makes clear that the portions of Dajer on which the Examiner relied do not teach the invention recited in Applicant's claims.

In the final office action, the Examiner stated that Dajer *inherently* teaches the functions of receiving a digital signal that defines both bearer data and control information and parsing from the control information both a power level and a modulation frequency, since, in the Examiner's view, a mobile switching center must always establish the power level for each channel of bearer data before the mobile switching center sends the data to base stations. In particular, the Examiner asserted: "[B]efore the bearer data transfer from 104 to 109-110, mobile switching center always establishes power level for each channel before it send it, so it's inherent." This statement by the Examiner, however, is incorrect and also fails to establish any teaching in Dajer of Applicant's claimed invention.

First, as explained in Applicant's response filed July 11, 2006, an MSC does not always establish a power level for each channel. Rather, as is known in the art, a base station, rather than an MSC, may establish a power level for transmission. Therefore, the mere fact that Dajer teaches transmission of signals from an MSC to a base station does not necessarily mean that the MSC would have determined a power level for the signals.

Furthermore, even if Dajer did inherently teach an MSC establishing a power level for each channel before sending the channel to a base station, such a teaching would not amount to what is recited in Applicant's claims (either inherently or explicitly), since Applicant's claims specifically recite receiving a signal that defines both the bearer data and control information and parsing from the control information a modulation frequency and a power level, among other elements. The mere concept of an MSC establishing a power level for a channel before transmitting it does not suggest receiving a signal that defines both bearer data and control

information and parsing from the control information both *a modulation frequency* and *a power level* as recited in the claims. Still further, the Examiner has not pointed to any such teaching in Dajer, and so the Examiner has clearly not made out an adequate case of anticipation under the law.

In the advisory action mailed August 4, 2006, the Examiner apologized for mistakenly concluding that elements of Applicant's claimed invention are inherent on grounds of a mobile switching center always establishing a power level for each channel before sending bearer data to base stations. The Examiner then stated that, what the Examiner meant to say was: "[B]efore the bearer data transfers from 104 to 109-110, it always establishes power level for each channel before it send it, so it's inherent." However, this position is equally or even more insufficient. First, this new statement by the Examiner fails to identify what "it" is that always establishes power level and sends bearer data. If the Examiner still means that the MSC always does so, the same deficiency noted above still applies. In any event, no such disclosure exists inherently or explicitly in Dajer, and such a disclosure would still fail to constitute Applicant's claimed invention, as explained above.

In the advisory action, the Examiner also raised an issue regarding the term "defines" as used in Applicant's claims. In particular, the Examiner asserted that the phrase "receiving a digital signal that defines" does not necessarily mean receiving a digital signal that "includes" or "contains." Thus, the Examiner concluded the use of the word "defines" in the claim "means that the definition of receiving a digital signal is bearer data and control information for each of a plurality of channel which is not true all the time and it have variety of meaning in real world."

To the extent Applicant can understand what the Examiner was trying to say in this regard, it seems the Examiner may have meant that Applicant's claim language does not mean that the signal "contains" or "includes" the control information. Yet a review of Applicant's

claims as a whole makes very clear that such an assertion would be erroneous. The claims recite parsing from the control information a power level and a modulation frequency. Clearly, the control information would need to be information that is included within the signal in order for a power level and a modulation frequency to be *parsed* from the control information. Therefore, Applicant submits that the Examiner's apparent assertion regarding the word "defines" is inapposite.

As noted above and as explained in Applicant's response after final, Dajer fails to explicitly or inherently teach Applicant's claimed invention, including at least the elements of (a) receiving a signal that defines both bearer data for a plurality of channels and control channel information for each channel and (b) parsing from the control information a power level and a modulation frequency, for use in generating an analog signal representing the bearer data. Consequently, Dajer does not anticipate Applicant's claims.

Given that the Examiner has failed to point to any teaching in Dajer that explicitly or inherently teaches Applicant's claimed invention, the Examiner has not made out the requisite case of anticipation. Therefore, Applicant submits that all of the pending claims are allowable.

For these reasons, Applicant respectfully requests the panel to withdraw the rejections of all of the pending claims, and to direct that a Notice of Allowance be mailed.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Dated: September 14, 2006

By: 

Lawrence H. Aaronson
Reg. No. 35,818